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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* JULIE A. SCHWARTZ,  
9 JAMES H. SCHWARTZ,  
10 JEANE S. CHEN,  
11 HARRY E. GRUBER, and  
12 EPHRAIM FEIG  
13

14  
15 Appeal 2009-003994  
16 Application 09/764,787  
17 Technology Center 3600  
18

19  
20 Decided: November 20, 2009  
21

22  
23 Before HUBERT C. LORIN, LINDA E. HORNER, and  
24 ANTON W. FETTING, *Administrative Patent Judges*.  
25 FETTING, *Administrative Patent Judge*.

26 DECISION ON APPEAL

27  
28 An oral hearing was held on October 22, 2009.



- 1           58. A method for conducting a fundraising campaign by an  
2           organization over a wide-area network, comprising the steps of:
- 3           [1] hosting a website including a plurality of linked web pages,  
4           the website
- 5                     providing information about the fundraising campaign  
6                     and
- 7                     soliciting potential donors to make a charitable  
8                     contribution to the fundraising campaign;
- 9           [2] providing a link to a personal donation page
- 10                    in one or more email messages to third parties,  
11                    the personal donation page having the name and personal  
12                    campaign goal of a solicitor registered on the website;
- 13           [3] receiving a charitable contribution
- 14                    via the personal donation page from a donor;
- 15           [4] updating,
- 16                    according to instructions from the donor,  
17                    one or more virtual plaques displayed on one or more  
18                    web pages
- 19                    to recognize new donors;
- 20           [4] forming teams on the website,
- 21                    to participate in the fundraising campaign  
22                    by soliciting donations by emails,  
23                    wherein the teams compete with each other to raise  
24                    money; and
- 25           [5] displaying team ranks on the virtual plaques.
- 26

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10, 2007), and the Examiner's Non-Final Rejection ("Non-Final Rej.,"  
mailed July 6, 2006) and Answer ("Ans.," mailed October 9, 2007).

THE REJECTIONS<sup>2</sup>

The Examiner relies upon the following prior art:

Costin US 20020049816 A1 Apr. 25, 2002

McBrearty, B.R. "What's Ahead For Telemarketing", Fund Raising Management, (December 1986), pp. 1, 4, 71-76.

Smith, G.E. "The impact of direct marketing appeals on charitable marketing effectiveness", Journal of the Academy of Marketing Science, v24n3 (Summer 1996), pp. 1-18

Gale Group, BT: Sheryl Gascoigne and Anna Walker bring a touch of glamour to BT Swimathon '99", M2 Presswire, (Nov. 27, 1998), pp. 1-4

Leukaemia Busters Fundraising Week, 26th June - 4th July 1999, pp. 1

Claims 58-72, 75-81, 82-94, 97-101, 102, and 106-107 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters.<sup>3</sup>

Claims 58-72, 75-94, and 97-107 stand provisionally rejected under the doctrine of obviousness-type double patenting.<sup>4</sup>

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<sup>2</sup> The Appellants also argue a hypothetical rejection for alleged new matter. App. Br. 6:¶ II. The Examiner did not make a rejection under 35 U.S.C. § 112, first paragraph. The Examiner instead, objected to the entry of an amendment filed on December 16, 2005. Non-Final Rej. 2-3. Thus a rejection for new matter is not before us. Appeal as to an Examiner objection is by way of petition to the Director of the U.S. Patent and Trademark Office under 37 C.F.R. 1.181. See MPEP 1002.02(c)(4).

<sup>3</sup> Claims 103-105 are also rejected under 35 U.S.C. § 103(a) (Non-Final Rej. 5-13) but these rejections are not appealed by the Appellants. Ans. 4.

<sup>4</sup> This rejection entered at Non-Final Rej. 3 is not repeated in the Answer, presumably because the Appellants agreed to file a terminal disclaimer which would obviate the rejection at allowance. App. Br. 18.

1 ARGUMENTS

2 The Appellants contend that none of the references describe the personal  
3 web page as used in limitations [2] and [3]. App. Br. 9-10. The Appellants  
4 also present evidence of secondary considerations of non-obviousness.

5 ISSUES

6 The issue of whether the Appellants have sustained their burden of  
7 showing that the Examiner erred in rejecting claims 58-72, 75-81, 82-94, 97-  
8 101, 102, and 106-107 under 35 U.S.C. § 103(a) as unpatentable over  
9 Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters turns on  
10 whether it was predictable to use a personal web page with Costin in view of  
11 the evidence of non-obviousness.

12 FACTS PERTINENT TO THE ISSUES

13 The following enumerated Findings of Fact (FF) are believed to be  
14 supported by a preponderance of the evidence.

15 *Facts Related to the Prior Art*

16 *Costin*

17 01. Costin is directed to online marketing applications for e-  
18 businesses using a fundraising system that allows e-businesses to  
19 partner with causes, such as charitable, non-profit and community  
20 organizations, to host fundraising events online with interactive  
21 participation by all involved. Costin ¶ 0006.

1           02. Costin describes the advantages of its use of the internet and e-  
2           mail to raise money as creating a viral marketing campaign.  
3           Costing ¶ 0007.

4           03. Costin describes enabling customers, employees, and donors to  
5           become individual fund-raisers by setting up a personalized  
6           campaign page and sending e-mails to anyone they choose,  
7           including friends, family and colleagues. Costin ¶ 0010.

8           04. Costin describes providing e-mail recipients with a message  
9           identifying the person forwarding the email and a message  
10          explaining that person's association or experiences with the cause.  
11          The email message typically includes links to the campaign page,  
12          where the potential donor may learn about the event and make  
13          secure, credit card or other donations or contributions. Costin ¶  
14          0010.

15          05. Costin's email message may also include contact information or  
16          links to other sites, such as the e-business or sponsor web site, the  
17          cause's web site, the forwarding donor's web site or email address.  
18          In this hierarchy, the initial donor/fund-raiser who forwards the  
19          email may be referred to as the "primary" donor and the potential  
20          donor receiving the email as the "secondary" donor, and so forth  
21          and so on. Costin ¶ 0010.

22          06. Costin describes a process in which a fundraising service  
23          provider facilitates joining causes by having a sponsor host an  
24          online fundraising campaign associated with and for the benefit of  
25          a cause. A host sponsor maintains a web site and one or more web

pages at the sponsor site may be dedicated to a fundraising campaign having an online component. Costin ¶ 0066.

07. Costin also describes implementing in a portal fashion, whereby a particular sponsor provides its customers, such as students or student-run organizations, with the ability to set up a fundraising campaign. This system enables fund-raisers to create individual dedicated fundraising campaign pages for particular organizations, for instance, fraternities, athletic teams, etc. In this manner, individual students or groups of students or the like may set up a dedicated fundraising campaign to send email messages to identified recipients to request donations or other assistance in conjunction with a particular cause or event. Costin ¶ 0084.

*McBrearty*

08. McBrearty is directed to describing the use of telemarketing in fund raising. One fund raising expert noted that personalization is a key concept to develop a personal relationship with donors. McBrearty: Abstract.

*Smith*

09. Smith is directed to charitable giving guidelines based on behavioral research. Smith: Abstract.

10. Smith describes displaying a list of donors and the sizes of others' donations as a visual anchor for affecting donor behavior. Smith: Fifth page.



1        *Gale Group*

2            11. Gale Group is directed to describing the fund raising strategy  
3            used by BT Swimathon '99. One aspect was the formation of  
4            teams. Gale Group: First page.

5        *Leukaemia Busters*

6            12. The article Leukaemia Busters is directed to a fund raising  
7            campaign and describes the use of teams in fund raising.  
8            Leukaemia Busters: Left column.

9        *Facts Related To The Level Of Skill In The Art*

10           13. Neither the Examiner nor the Appellants have addressed the  
11           level of ordinary skill in the pertinent arts of systems analysis and  
12           programming, non-profit management, or fund raising. We will  
13           therefore consider the cited prior art as representative of the level  
14           of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d  
15           1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings  
16           on the level of skill in the art does not give rise to reversible error  
17           ‘where the prior art itself reflects an appropriate level and a need  
18           for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*  
19           *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

20        *Facts Related To Secondary Considerations*

21           14. The Appellants present two articles, a set of customer  
22           testimonials, and an Examiner interview summary as evidence of  
23           secondary considerations. The interview summary contains an  
24           Examiner finding that Costin alone does not describe limitation

[3]. None of the remaining pieces of evidence make any comparison between the results of the claimed invention and that of Costin.

## PRINCIPLES OF LAW

### *Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1]) the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also*, *KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

## ANALYSIS

*Claims 58-72, 75-81, 82-94, 97-101, 102, and 106-107 rejected under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters.*

The Examiner found that Costin described all the limitations of claim 58 except for a personal web page, a virtual plaque and the use of teams. The

Examiner found that McBrearty suggested the use of a personal web page, Smith suggested a virtual plaque and that each of Gale Group and Leukaemia Busters described the use of teams. Ans. 4-13.

The Appellants argue that none of the references describe or suggest using a personal donation page. App. Br. 8-9. The Appellants also submitted two articles, a set of customer testimonials, and an Examiner interview summary as evidence of secondary considerations.

We agree with the Examiner that Costin describes limitations [1], [2], and [3] except for using a personal web page as a donation page. Costin describes hosting a web site with links to pages and providing information about a fundraising campaign. FF 06. Costin describes having individuals send emails to potential donors, where the emails have links to a donation page. FF 04. Costin describes receiving a contribution via the donations page. FF 04. Smith describes posting information about goals and actual donations as in limitation [4] and both Gale Group and Leukaemia Busters describe the use of teams in fundraising as in limitations [5] and [6]. Thus the issue remaining is that raised by the Appellants of whether it would have been obvious to use a personal web page for the donations page in Costin.

First we find that the only distinction between the personal donations page as claimed and the donations page in Costin is the content of the web page. That is, the only distinction is in the text, graphics, or multimedia contents that are used to elicit a donation. There is no functional distinction between the claimed personal web page and Costin's donation page. In light of that, McBrearty's description of personalization as a key concept in getting donations (FF 08) would have suggested to one of ordinary skill in

the fundraising arts to personalize solicitations wherever practical. Such a suggestion as applied to Costin would have directly led to personalizing the donation page as found by the Examiner. Thus, we find the arguments by the Appellants unpersuasive.

As to the evidence proffered of commercial success, while they tend to show that the general techniques used by the Appellants were superior to non-internet based methods, the evidence does not recite the particular techniques employed that resulted in the laudatory comments for comparison with the claimed steps and more critically, does not show any comparison to the closest prior art such as that in Costin. Thus, the articles do not provide evidence to overcome the conclusion of obviousness based on the closest prior art.

*Claims 75 and 97*

Claims 75 and 97 depend from cancelled claims and so the scope of these claims is indeterminate. As a procedural matter, we reverse the rejection of claims 75 and 97 under § 103. A rejection of a claim, which is so indefinite that “considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims” is needed, is likely imprudent. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (holding that the examiner and the board were wrong in relying on what at best were speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon.)

We find it imprudent to speculate as to the scope of claims 75 and 97 in order to reach a decision on the obviousness of the claimed subject matter under § 103. It should be understood, however, that our reversal is based on

the indefiniteness of the claimed subject matter and does not reflect on the merits of the underlying rejection.

*Claims 58-72, 75-94, and 97-107 provisionally rejected under obvious double patenting.*

The Appellants do not argue this rejection, but instead agree to file a terminal disclaimer at the time of allowance, which would obviate this rejection. App. Br. 18.

As with the obviousness rejection, *supra*, claims 75 and 97 depend from cancelled claims and so the scope of these claims is indeterminate. As a procedural matter, we reverse the rejection of claims 75 and 97 under the doctrine of obviousness-type double patenting for reasons similar to those we found in the obviousness rejection analysis. It should be understood, however, that our reversal is based on the indefiniteness of the claimed subject matter and does not reflect on the merits of the underlying rejection.

#### NEW GROUND OF REJECTION

The following new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 75 and 97 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

Each of these claims is written in dependent form incorporating the subject matter of a cancelled parent claim. Claim 75 incorporates limitations from cancelled claim 73. Claim 97 incorporates limitations from cancelled claim 95. As cancelled claims are non-existent from the standpoint of the record, any such limitations are necessarily indeterminate. Thus, we enter a new ground of rejection of claims 75 and 97 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim what Appellants' intend as their invention.

#### CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 58-72, 76-81, 82-94, 98, 100, 101, 102, and 106-107 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters.

We reverse the rejection of claims 75 and 97 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters because the claims are indeterminate and their scope is unknown.

The Appellants have not sustained their burden of showing that the Examiner erred in provisionally rejecting claims 58-72, 76-94, and 98-107 under the doctrine of obviousness-type double patenting.

We reverse the rejection of claims 75 and 97 under the doctrine of obviousness-type double patenting because the claims are indeterminate and their scope is unknown.

The Appellants did not appeal the following rejections. These claims are among those appealed in the provisional obviousness double patenting

rejection. These rejections remain and we accordingly summarily affirm them.

Claim 103 under 35 U.S.C. § 103(a) as unpatentable over Costin and McBrearty.

Claim 104 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, and Smith

Claim 105 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters

A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 75 and 97 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

## DECISION

To summarize, our decision is as follows.

- The rejection of claims 58-72, 76-81, 82-94, 98, 100, 101, 102, and 106-107 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters is sustained.
- The rejection of claims 75 and 97 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters is not sustained.
- The provisional rejection of claims 58-72, 76-94, and 98-107 under the doctrine of obviousness-type double patenting is sustained.
- The provisional rejection of claims 75 and 97 under the doctrine of obviousness-type double patenting is not sustained.

- 1       • The Appellants did not appeal the following rejections, and so they  
2       are summarily affirmed.
  - 3           ○ Claim 103 under 35 U.S.C. § 103(a) as unpatentable over  
4           Costin and McBrearty.
  - 5           ○ Claim 104 under 35 U.S.C. § 103(a) as unpatentable over  
6           Costin, McBrearty, and Smith
  - 7           ○ Claim 105 under 35 U.S.C. § 103(a) as unpatentable over  
8           Costin, McBrearty, Smith, and Gale Group or Leukaemia  
9           Busters
- 10      • A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).
  - 11          ○ Claims 75 and 97 are rejected under 35 U.S.C. § 112, second  
12          paragraph, as failing to particularly point out and distinctly  
13          claim the invention.

14       Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides  
15       “Appellant may file a single request for rehearing within two months from  
16       the date of the original decision of the Board.”

17       In addition to affirming the Examiner's rejection(s) of one or more  
18       claims, this decision contains new grounds of rejection pursuant to 37 C.F.R.  
19       § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides “[a] new ground of  
20       rejection pursuant to this paragraph shall not be considered final for judicial  
21       review.”

22       37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO  
23       MONTHS FROM THE DATE OF THE DECISION, must exercise one of



the following two options with respect to the new grounds of rejection to  
avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

41.50(b)

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